## Remarks

Claims 1-8, 10-15, 17-24, 26, 28-42, 44-48, 50-55 and 57 are pending. Claims 1-8, 10-15, 17-24, 26, 28-42, 44-48, 50-55 and 57 are rejected.

Claims 18 and 51 were rejected under 35 U.S.C. 112, first and second paragraphs. Claims 18 and 51 have been cancelled.

Claims 10 and 44 were rejected under 35 U.S.C. 112, second paragraph. See, Office Action, July 13, 2009, pp. 3-4 ("Claims 10 and 44 recite the limitation 'A loss mitigation tool' in the preamble . . . . As written, the Examiner interprets the tool to be an insurance policy, which is classified as non-functional descriptive material and is not patentable subject matter . . . .") In response, Applicants note that claims 10 and 44 each recite "an electronic backup copy of the insured entity's data . . . .", which cannot be classified as merely non-functional descriptive material. Claims 10 and 44 are not indefinite, and therefore are patentable under 35 U.S.C. 112, second paragraph.

Claims 1-8, 10-15, 17, 26-42, 44-48, 50 and 57 were rejected under 35 U.S.C. 101. Independent claims 1, 10, 26, 32, 37 and 44 have been amended to address this rejection consistent with the suggestions made by the Examiner during the October 14, 2009 telephone conference.

Claims 1-31 and 37-56 were rejected under 35 U.S.C. 102(b) as anticipated by U.S. Pat. Pub. 2002/0095317 (McCabe). Claims 32-36 were rejected under 35 U.S.C. 103(a) as unpatentable over McCabe and the PR Newswire article. Claim 57 was rejected under 35 U.S.C. 103(a) as unpatentable over McCabe, the PR Newswire article, and what the Examiner has taken Official Notice of.

**The references do not disclose or suggest each limitation of the claims.**

With regard to amended claim 26, McCabe does not disclose "storing, by a second processing device, an electronic backup copy of the insured's data by the data protection service provider, as required by the agreements, on a storage medium of the data protection service provider such that the electronic backup copy is insured against loss according to the agreements." Rather, McCabe appears to insure data stored at the insured's business site (as opposed to backup copies held by a data protection service provider, as in Applicants' invention): McCabe's premium rates for its insurance of local data are based on exposure periods that are, in turn, based on the periodicity with which backups of the local data are created. See, e.g., McCabe [0105]-[0106] ("[T]he business uses remote data mirroring technology . . . to backup the data within five minutes at a remote data 210 storage facility 212 . . . . The insurance underwriter calculates . . . the exposure period for data loss at five minutes."); McCabe [0109]-[0110] ("To calculate 306 a premium, the underwriter 302 determines that the business 304 receives an average of one hundred hits per minute 412, and that the average value of a hit to the business is $2 . . . . It takes an average of thirty minutes to detect the quality-of-service problem, determine that a transition . . . is justified, and fully transition service 406 from the main server to one of the standby servers. Thus the exposure amount is one hundred hits per minute times thirty minutes times $2 per hit . . . .") Hence, a loss of local data at an insured's business site of McCabe (as opposed to a loss of backup data held by a data protection service provider) will trigger McCabe's insurance.

**The Examiner's Section 103 rejection does not establish a *prima facie* case of obviousness.**

With regard to claim 32, the Examiner asserts that

> PR Newswire teaches a company paying a monthly fee in order to be the exclusive service provider in a neighborhood (see: abstract). It would have been obvious . . . to include in the required data protection services of McCabe, the fee to be an exclusive service provider as taught by PR Newswire because the claimed invention is merely a combination of old elements, and in the combination, each element merely would have performed the same function as is did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Office Action, July 13, 2009, p. 14-15.

PR Newswire's disclosure of a company paying a monthly fee in order to be the exclusive provider of, for example, real estate services in a neighborhood, however, has no relationship with McCabe's data insurance. Becoming an exclusive service provider within some geographic region is not at issue in McCabe. See, McCabe. Applicants submit that such a combination could only be constructed with the benefit of hindsight. One of ordinary skill would not have had reason to combine the references as suggested by the Examiner.

Claims 1, 10, 32, 37 and 44, the other independent claims, are patentable for the reasons claim 26 is patentable. Similarly, the dependent claims are patentable because they depend from one of the independent claims.

Applicants submit that the claims are in condition for allowance and respectfully request a notice to the effect. Applicants' Attorney also invites a telephone conference if the Examiner believes it will advance the prosecution of the application.

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Respectfully submitted,

**JOHN PAUL CONN ET AL.**

By /Benjamin C. Stasa/
Benjamin C. Stasa
Reg. No. 55,644
Attorney for Applicants

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**BROOKS KUSHMAN P.C.**
1000 Town Center, 22nd Floor
Southfield, MI 48075-1238
Phone: 248-358-4400
Fax: 248-358-3351